

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Timothy J. Chainer Confirmation No. 3892

Serial No. 10/720,352 Group Art Unit 2632

Filed November 25, 2003 Examiner Pope, Daryl C.

For EVENT RECORDER FOR TRANSMITTING AND STORING
ELECTRONIC SIGNATURE DATA

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

REQUEST TO RESCIND OFFICE ACTION AND MAIL
NEW OFFICE ACTION

Sir:

An office action was mailed in the above-identified application on December 14, 2004.

The office action is in error in that it does not act on the claims at issue in the case. As evidence of the same, applicant attaches hereto copies of (1) the transmittal papers filed with the application which specifically indicates on page 2 that an information disclosure statement and preliminary amendment were filed with the application, (2) a copy of the preliminary amendment filed with the application which cancels claims 1-33 and adds new claims 34-45, (3) a copy of the information disclosure statement with attached form PTO 1449, and (4) a copy of the date stamped receipt from the USPTO dated November 25, 2003 which clearly identifies the preliminary amendment and information disclosure statement being filed with the application.

In the office action dated December 14, 2004, the Examiner purports to act on claims 1-33, and provides no action on claims 34 -45. This action is clearly erroneous since claims 1-33 were canceled when the application was filed, and claims 34-45 were clearly added by amendment when the application was filed. Further, the office action of December 14, 2004 fails to indicate consideration of the references cited in the IDS filed with the application.

The undersigned has made a number of telephone calls to the Examiner and to the Examiner's Supervisor, but has been unable to have the action withdrawn. Based on the attachments hereto, the undersigned requests withdrawal of the action mailed December 14, 2004, and issuance of a new office action or notice of allowance focused on claims 34-45, as well as specific consideration of the references cited in the IDS.

Respectfully submitted,

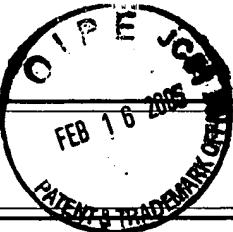


Michael E. Whitham
Reg. No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

Tel. (703) 787-9400
Fax. (703) 787-7557

Customer No.: 30743



JRW

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
00280428BC

In Re Application Of: T. Chainer, et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/720,352	11/25/03	D.C. Pope	30743	2632	3892

Title: Event Recorder for Transmitting and Storing Electronic Signature Data

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Request to Rescind Office Action and Mail New Office Action with a copy of the following documents:

1. transmittal document
2. Preliminary Amendment
3. IDS
4. postcard receipt from USPTO w/date stamp of 11/25/03

Postcard

in the above identified application.

No additional fee is required.

A check in the amount of _____ is attached.

The Director is hereby authorized to charge and credit Deposit Account No. 50-0510 as described below.

Charge the amount of _____

Credit any overpayment.

Charge any additional fee required.

Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Dated: 2/16/05

Michael E. Whitham

Reg. No. 32,635

Whitham, Curtis & Christofferson, PC
11491 Sunset Hills Road - #340
Reston, VA 20190
703/787-9400
Customer No. 30743

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____.

(Date)

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:

**UTILITY PATENT APPLICATION TRANSMITTAL
(Large Entity)**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
00280428BC

Total Pages in this Submission

TO THE COMMISSIONER FOR PATENTS

Mail Stop Patent Application
P.O. Box 1450
Alexandria, VA 22313-1450

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

EVENT-RECORDER FOR TRANSMITTING AND STORING ELECTRONIC SIGNATURE DATA

COPY

and invented by:

Timothy J. Chainer, Claude A. Greengard, Charles P. Tresser, Chai W. Wu

If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:

Continuation Divisional Continuation-in-part (CIP) of prior application No.: 09/989,468

Which is a:

Continuation Divisional Continuation-in-part (CIP) of prior application No.: 09/233/487

Which is a:

Continuation Divisional Continuation-in-part (CIP) of prior application No.: _____

Enclosed are:

Application Elements

1. Filing fee as calculated and transmitted as described below

2. Specification having 19 pages and including the following:
 - a. Descriptive Title of the Invention
 - b. Cross References to Related Applications (*if applicable*)
 - c. Statement Regarding Federally-sponsored Research/Development (*if applicable*)
 - d. Reference to Sequence Listing, a Table, or a Computer Program Listing Appendix
 - e. Background of the Invention
 - f. Brief Summary of the Invention
 - g. Brief Description of the Drawings (*if filed*)
 - h. Detailed Description
 - i. Claim(s) as Classified Below
 - j. Abstract of the Disclosure

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UTILITY PATENT APPLICATION TRANSMITTAL
(Large Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
00280428BC

Total Pages in this Submission

Application Elements (Continued)

3. Drawing(s) (*when necessary as prescribed by 35 USC 113*)

a. Formal Number of Sheets _____ 3
b. Informal Number of Sheets _____

COPY

4. Oath or Declaration

a. Newly executed (*original or copy*) Unexecuted
b. Copy from a prior application (37 CFR 1.63(d)) (*for continuation/divisional application only*)
c. With Power of Attorney Without Power of Attorney
d. **DELETION OF INVENTOR(S)**

Signed statement attached deleting inventor(s) named in the prior application,
see 37 C.F.R. 1.63(d)(2) and 1.33(b).

5. Incorporation By Reference (*usable if Box 4b is checked*)

The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

6. CD ROM or CD-R in duplicate, large table or Computer Program (Appendix)

7. Application Data Sheet (See 37 CFR 1.76)

8. Nucleotide and/or Amino Acid Sequence Submission (*if applicable, all must be included*)

a. Computer Readable Form (CRF)
b. Specification Sequence Listing on:
i. CD-ROM or CD-R (2 copies); or
ii. Paper
c. Statement(s) Verifying Identical Paper and Computer Readable Copy

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Accompanying Application Parts

9. Assignment Papers (*cover sheet & document(s)*)

10. 37 CFR 3.73(B) Statement (*when there is an assignee*)

11. English Translation Document (*if applicable*)

12. Information Disclosure Statement/PTO-1449 Copies of IDS Citations

13. Preliminary Amendment

14. Return Receipt Postcard (MPEP 503) (*Should be specifically itemized*)

15. Certified Copy of Priority Document(s) (*if foreign priority is claimed*)

16. Certificate of Mailing

First Class Express Mail (*Specify Label No.*): Hand Delivered

UTILITY PATENT APPLICATION TRANSMITTAL
(Large Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
00280428BC

Total Pages in this Submission

Accompanying Application Parts (Continued)

17. Additional Enclosures (*please identify below*):

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Request That Application Not Be Published Pursuant To 35 U.S.C. 122(b)(2)

18. Pursuant to 35 U.S.C. 122(b)(2), Applicant hereby requests that this patent application not be published pursuant to 35 U.S.C. 122(b)(1). Applicant hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing of the application.

Warning

An applicant who makes a request not to publish, but who subsequently files in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), must notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

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UTILITY PATENT APPLICATION TRANSMITTAL
(Large Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
00280428BC

Total Pages in this Submission

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Fee Calculation and Transmittal

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	12	- 20 =	0	x \$18.00	\$0.00
Indep. Claims	1	- 3 =	0	x \$86.00	\$0.00
Multiple Dependent Claims (check if applicable)	<input type="checkbox"/>				\$0.00
				BASIC FEE	\$770.00
OTHER FEE (specify purpose)					\$0.00
				TOTAL FILING FEE	\$770.00

A check in the amount of _____ to cover the filing fee is enclosed.
 The Director is hereby authorized to charge and credit Deposit Account No. 50-0510
as described below.

Charge the amount of \$770.00 as filing fee.
 Credit any overpayment.
 Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
 Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance,
pursuant to 37 C.F.R. 1.311(b).

COPY



Signature

Michael E. Whitham
Reg. No. 32,635
Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
(703) 787-9400
Customer Number 30743

Dated: November 25, 2003

cc:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

In re patent application of

Timothy Chainer

Serial No. (Not assigned)

Group Art Unit: (not assigned)

Filed (concurrently herewith)

Examiner: (not assigned)

For : EVENT-RECORDER FOR TRANSMITTING AND STORING

ELECTRONIC SIGNATURE DATA

This application is a continuation of, and claims priority to the following application, which has now been allowed:

Timothy Chainer

Serial No. 09/989,468

Group Art Unit: 2632

Filed: November 21, 2001

Examiner: Tong, Nina C.

For: EVENT-RECORDER FOR TRANSMITTING AND STORING

ELECTRONIC SIGNATURE DATA

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

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PRELIMINARY AMENDMENT

Sir:

Prior to examination on the merits, please enter the following amendments in the application:

Amendments to the Specification begin on page 2

Listing of the Claims with Amendments begin on page 3

Remarks begin on page 5

COPY**Amendments to the Specification**

Please insert following paragraph at Page 1, after the title and before the description:

This application is a continuation of U.S. Patent Application S.N. 09/989,468 filed November 21, 2001, which is a division of U.S. Patent Application 09/233,487 filed January 20, 1999, now U.S. Patent 6,525,672.

Please amend the paragraph on page 8, at lines 4-14, as follows:

In addition to identifying the vehicle registration, the signature may also include the vehicle's speedometer setting at the time of the collision and any other parametric data such as acceleration, temperature, and the status of the vehicle's lights, (e.g., headlights, stop lights, turn signals, etc.). Furthermore, as shown in Figure 1C traffic lights †52 132 may also be equipped to transmit encrypted data such as the time, and state of the light (i.e., green, yellow or red) when prompted. This data is also received by both vehicles if they are close enough to the traffic light.

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Listing of the Claims**COPY**

Claims 1-33. Cancel

Claim 34 (new). An electronic event recorder for monitoring vehicles, comprising:

a memory for storing signature data related to a vehicle;

at least one sensor for sensing the occurrence of an event selected from the group consisting of tampering with the electronic event recorder, tampering with cargo associated with said vehicle, and tampering with locks associated with said vehicle;

at least one transmitter and receiver for transmitting said signature data and receiving data from a remote transmitter, respectively; and

a microprocessor associated with said sensor, said memory, said transmitter and said receiver, which, upon sensing said event, causes performance of one or more of the following

causes the vehicle to be disabled,

causes said transmitter to stop transmitting said signature data to a remote receiver, or

causes said transmitter to transmit said signature data to said remote receiver.

Claim 35 (new). The electronic event recorder of claim 34 wherein said memory, said microprocessor, and said sensor are associated with a smart card.

Claim 36 (new). The electronic event recorder of claim 34 wherein said transmitter and receiver are integrated on a smart card.

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Claim 37 (new). The electronic event recorder of claim 34 wherein said memory, said microprocessor, said sensor, and said transmitter and receiver are associated with a smart card.

Claim 38 (new). The electronic event recorder of claim 34 wherein said sensor

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senses tampering with the electronic event recorder.

Claim 39 (new). The electronic event recorder of claim 34 wherein said sensor senses tampering with cargo associated with said vehicle.

Claim 40 (new). The electronic event recorder of claim 34 wherein said sensor senses tampering with locks associated with said vehicle.

Claim 41 (new). The electronic event recorder of claim 34 wherein upon sensing the event, the microprocessor causes the vehicle to be disabled.

Claim 42 (new). The electronic event recorder of claim 34 wherein upon sensing the event, the microprocessor causes said transmitter to stop transmitting said signature data to a remote receiver.

Claim 43 (new). The electronic event recorder of claim 34 wherein upon sensing the event, the microprocessor causes said transmitter to transmit said signature data to said remote receiver.

Claim 44 (new). The electronic event recorder of claim 34 wherein the signature data is encrypted.

Claim 45 (new). The electronic event recorder of claim 34 further comprising a clock, said transmitter transmitting said signature data based on signals from said clock.

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REMARKS

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The specification has been corrected in the same manner as was done in the parent application, and now comports with what is shown in Figure 1C of the application.

Claims 1- 33 have been canceled. Claim 34-45 have been added. The added claims are substantially directed to the subject matter of claim 12 of the application as originally filed.

The invention provides the ability to verify that certain events have occurred by transmission of a digital signature and encrypted data to a data acquisition system. This, in effect, leaves an electronic fingerprint which can be verified and authenticated. As shown in Figure 1A, and discussed in the application on pages 5 and 6, a smart card can be used in the practice of this invention, and can be maintained in a tamper proof housing 106. The smart card can be connected to or have on board one or more sensors 105. The smart card would include a memory 103, processing units 104, and an encryption module 107. The smart card is connected to a receiver 110 and transmitter 120. As explained on page 6 of the application, these components 110 and 120 may be integrated onto the card or be discrete components. Also it should be clear that one device (e.g., a transceiver) might be used as both a receiver 110 and a transmitter 120. Figures 1b and 1c show use of the device of this invention with transmitters and receivers at remote locations such as a road side station, a traffic light, or another identical device.

The text on page 6, lines 1-2, discuss disabling the vehicle when tampering is detected. The text on pages 8 and 9 of the application discuss having, for example, a truck with one of the devices, stopping transmission upon of the signature data upon detecting tampering of the event recorder, cargo or lock. In this instance, for example, a truck that is not transmitting a signal may be subject to manual inspection. Claim 12 as originally filed, discusses transmitting the signature data upon the occurrences of an event (i.e., tampering with locks or the event recorder. A practical example of the technology could be the situation where cargo loaded on boat bound for the Port of Baltimore is tampered with en route, such as might occur if a terrorist cell intends to illegally import weapons or the

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like, the sensor would transmit the vehicle signature data (i.e., the boat and cargo container) upon the occurrence of tampering such that Customs Officials could readily know in advance to search the vessel upon its arrival. Likewise, as another example, tampering with the vehicle locking mechanisms of a car could result in transmitting the vehicle signature data to the police to alert the police of the possible theft of the vehicle.

Respectfully submitted,


Michael E Whitham
Reg. No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

COPY

Tel. (703) 787-9400
Fax. (703) 787-7557

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Chainer et al.

Serial No.: Not Assigned

Group Art Unit: Not Assigned

Filed: Concurrently

Examiner: Not Assigned

For: EVENT-RECORDER FOR TRANSMITTING AND STORING
ELECTRONIC SIGNATURE DATA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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INFORMATION DISCLOSURE STATEMENT

Sir:

Under the provisions of 37 C.F.R. 1.97 through 1.99 and pursuant to applicant's duty of disclosure under 37 C.F.R. 1.56, applicant respectfully brings the following documents, listed on the attached form PTO-1449, to the attention of the Examiner in charge of the above-identified application. Under the provisions of 37 C.F.R. 1.98(d) copies of the references are not required. Copies of the references can be found in the parent case (U.S. Patent Application Serial Number 09/989,468 filed 11/21/01).

This citation does not constitute an admission that the references are relevant or material to the claims. They are only cited as constituting related art of which the applicant is aware.

This statement shall not be construed as a representation that a search has been made or that no other art than that identified exists.

It is respectfully requested that the listed references be considered by the Examiner and formally made of record in this application.

Respectfully submitted,


Michael E. Whitham
Reg. No. 32,635

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Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
(703) 787-9400
Customer Number 30743

Notice of References Cited			Application/Control No.	Applicant(s)/Patent Under Reexamination CHAINER ET AL.	
			<i>Unassigned</i>	Examiner	Art Unit
			<i>Unassigned</i>	<i>Unassigned</i>	Page 1 of 2

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
X	A	US-5159629-	10-1992	Double et al.	380	4
X	B	US-5140634-	08-1992	Guillou et al.	380	23
X	C	US-4102493-	07-1978	Moreno	235	419
X	D	US-4092524-	05-1978	Moreno	235	419
X	E	US-4007355-	02-1977	Moreno	235	61.7
X	F	US-3971916-	07-1976	Moreno	235	61.7
X	G	US-5280159-	01-1994	Schultz et al.	231	382
	H	US-6141611-	10-2000	Mackey et al.	701	35
	I	US-5459304-	10-1995	Eisenmann	235	380
	J	US-6157321-	12-2000	Ricci	340	902
	K	US-5815093-	09-1998	Kikinis	340	937
	L	US-6076028-	06-2000	Donnelly et al.	701	45
	M	US-5471193-	11-1995	Peterson et al.	340	438

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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N	-	-				
O	-	-				
P	-	-				
Q	-	-				
R	-	-				
S	-	-				
T	-	-				

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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Notice of References Cited			Application/Control No.	Applicant(s)/Patent Under Reexamination CHAINER ET AL.	
			Examiner	Art Unit	Page 2 of 2

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-5790427-	08-1998	Greer et al.	364	556
	B	US-5056056-	10-1991	Gustin	364	900
	C	US-5465079-	11-1995	Bouchard et al.	340	576
	D	US-6076026-	06-2000	Jambhekar et al.	701	35
	E	US- -				
	F	US- -				
	G	US- -				
	H	US- -				
	I	US- -				
	J	US- -				
	K	US- -				
	L	US- -				
	M	US- -				

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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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	O	- -				
	P	- -				
	Q	- -				
	R	- -				
	S	- -				
	T	- -				

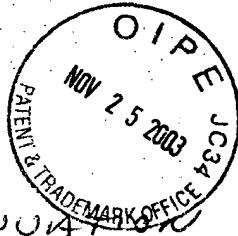
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NON-PATENT DOCUMENTS

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	V	
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*A copy of this reference is not being furnished with this Office action. (See MPEP, § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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CONTINUATION

REQUEST FOR EARLY NOTIFICATION OF SERIAL NUMBER

Docket No. 00280428BC In re: patent/ trademark application of
Chaser, Greengord Tresser Wu
For Event-Recorder for transmitting & storing
Electronic Signature DATA

19 Pages in Specification 12 No. of claims [1 independent; 11 dependent]
 3 Sheets of Drawings Abstract Specimens
 Transmittal Sheet Fee Calculation Form
 Combined Declaration and Power of Attorney Ver. Stmt/Sm Entity Status
 Assignment Recordation Form Cover Sheet
 Information Disclosure Statement PTO-1449 and associated art (docs.)
 Priority Document(s) Other Prelim. order.

Fees \$ 770 Deposit Account No. (if applicable) 50-0510
770 filing fee; Assignment charge; Extra Claims fee)

SERIAL NO.

Client Matter No. 00280428BC

Atty:Asst. L. E. W. L. H.

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